

**REMARKS**

This amendment is responsive to the Office Action dated July 30, 2003.

Applicant has added claims 28-31. Claims 1-31 are pending.

**Claim Rejections Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1, 3-13 under 35 U.S.C. § 102(b) as being anticipated by Chong (US Pat. No. 5,535,120). In the Office Action, the Examiner also rejected claims 1, 3-13 under 35 U.S.C. § 102(b) as being anticipated Yamauchi et al. (US Pat. No. 5,701,497).

Applicant notes at the outset that the Examiner's apparent intent was to reject claims 1, 3-12 under 35 U.S.C. § 102(b), and to reject claim 13 under 35 U.S.C. § 103(a). In the Examiner's detailed rejections under 35 U.S.C. § 102(b), the Examiner proffered no explanation as to how Chong or Yamauchi anticipates claim 13. Further, the Examiner in paragraph 7 of the Office Action rejected claim 13 under 35 U.S.C. § 103(a).

According to the Examiner, Chong and Yamauchi teach a method comprising transmitting an image containing text in a first language over a network and receiving a translation of the text in a second language over the network, as recited in claim 1. The Examiner also asserted that Chong and Yamauchi disclose displaying the image, as recited in claim 3, and displaying the image and displaying the translation of the text in the second language simultaneously, as recited in claim 4. The Examiner further asserted that Chong and Yamauchi disclose establishing a wireless connection with the network as recited in claim 5.

In addition, the Examiner stated that Chong and Yamauchi disclose transmitting a second image containing second text in the first language over the network and receiving a translation of the first text and the second text in the second language over the network, as recited in claim 6. The Examiner also declared that Chong and Yamauchi teach transmitting the first image and the second image over a network in response to a single command from a user, as recited in claim 7 (which the Examiner inadvertently referred to as claim 6). Further, the Examiner asserted that Chong and Yamauchi teach displaying one of the translation of the first text and the translation of the second text in response to a command from a user, as recited in claim 8.

The Examiner additionally stated that Chong and Yamauchi disclose compressing the image, as recited in claim 9, and receiving the image from an image capture device, as recited in claim 10. The Examiner also stated that Chong and Yamauchi teach prompting a user to provide additional information comprising at least one of an account number, a password, an identification of the first language, an identification of the second language, a dictionary and a server location, as recited in claim 11. Moreover, the Examiner stated that Chong and Yamauchi teach one of a wireless telecommunication network, a cellular telephone network, and the Internet, as recited in claim 12.

Applicant respectfully traverses the rejections.

In order to support an anticipation rejection under 35 U.S.C. § 102(b), it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule." "A single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim." Trintec Indus. Inc. v. Top-U.S.A. Corp., 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. § 102(b) is improper.

Claim 1 recites "transmitting an image containing text in a first language over a network." Chong does not teach transmitting an image containing text in a first language over a network, as recited in claim 1. Chong does not disclose transmitting image data over a network at all. Rather, Chong discloses transmitting "electronic text" or "input text." Chong, col. 5, line 67; col. 6, line 16; col. 7, line 35. The "text" is extracted from the image prior to transmission. Chong's Machine Translation Module 20, which receives information from Computer Server 10, receives "input text," not input image data. Col. 6, lines 15-17. Image data received by Computer Server 10 are converted into text by Recognition Module 12, which is a part of Computer Server 10. Col. 6, lines 42-45; col. 7, lines 15-16.

Similarly, Yamauchi does not teach transmitting an image containing text in a first language over a network, as recited in claim 1. Instead, Yamauchi discloses a facsimile apparatus that receives image data. Clearly, the Yamauchi facsimile device does not transmit image data for translation. Rather, Yamauchi discloses:

[T]he facsimile apparatus of FIG. 1 further includes an OCR (optical character reader) unit 8 for recognizing characters in the received image data. Thereby, the OCR unit 8 is supplied with the reproduced image data from the data decoder 6 and produces character codes corresponding to the recognized characters. Further, the facsimile apparatus includes a translation unit 9 that translates the received documents. More specifically, the translation unit 9 is supplied with the received document from the OCR unit 8 in the form of text data that includes character codes and translates the same from the original language to another language.

Yamauchi, col. 7, lines 35-47. The Yamauchi facsimile device therefore transmits "text data," not image data. Like the Chong device, the Yamauchi device includes a recognition module or OCR that extracts text from received image data. Yamauchi does not disclose transmitting an image containing text in a first language, as recited in Applicant's claim 1.

Moreover, as shown by the above-quoted language, the Yamauchi facsimile device translates from the first language to the second language prior to transmission. Claim 1, by contrast, recites transmitting an image containing text in a first language over a network and receiving a translation of the text in a second language over the network.

In view of the differences identified above, Chong and Yamauchi clearly fail to anticipate the features set forth in claim 1. Claims 3-12 depend upon claim 1, therefore Chong and Yamauchi likewise fail to anticipate the features set forth in claims 3-12.

In addition, Chong and Yamauchi fail to disclose features recited in claims 3-12, and therefore Chong and Yamauchi fail to anticipate claims 3-12.

Claim 3 recites displaying the image. Chong does not disclose displaying the image. The Examiner cited the Chong Optical Character Recognition device as a displaying device, but such a device is not a display, and Chong does not teach such a device as a display. As described in Chong, Optical Character Recognition converts image data into machine-readable text, col. 6, lines 44-45, which is clearly different from displaying as claimed in Applicant's claim 3. Similarly, Yamauchi does not disclose displaying the image. The Examiner cited the Yamauchi scanner as a displaying device, but such a device is an input device, see FIG. 1, not a display, and Yamauchi does not teach such a device as a display. For these additional reasons, claim 3 should be allowed.

Claim 4 recites displaying the image that contains text in the first language and displaying the translation of the text in the second language simultaneously. Chong does

not disclose displaying an image having text in the first language simultaneously with the translation in the second language, as recited in claim 4. Rather, Chong discloses displaying source text. Col. 19, lines 45, 47. Moreover, Chong FIG. 3 teaches displaying the source text and the target text separately rather than simultaneously. Chong discusses a footnoting function, but the footnoting function of Chong is described as displaying non-translatable graphic images, col. 19, lines 52-53. It is clear that Chong does not teach displaying the image that contains text in the first language and displaying the translation of the text in the second language simultaneously, as recited in claim 4.

Yamauchi discloses outputting a received document simultaneously in the first language and the second language. Col. 4, lines 50-52. Yamauchi does not disclose, however, displaying the image that contains text in the first language and displaying the translation of the text in the second language simultaneously, as recited in claim 4. Yamauchi discloses simultaneous printing of original text and translated text: "original text at the left is represented on the first page and the translation at the right is represented on the second page." Col. 20, lines 29-31. For these additional reasons, claim 4 should be allowed.

Claim 5 recites establishing a wireless connection with the network. Neither Chong nor Yamauchi discusses wireless connections or establishing wireless connections with a network, and the Examiner's citations to Chong nor Yamauchi are not on point. Accordingly, the rejections of claim 5 are clear improper for this additional reason.

Claim 6 recites a first image containing first text, and further recites transmitting a second image containing second text in the first language over the network, and receiving a translation of the first text and the second text in the second language over the network. As noted above, Chong and Yamauchi do not disclose transmitting image data containing text. It follows Chong and Yamauchi do not disclose transmitting multiple images containing text, as recited in claim 6. For these additional reasons, claim 6 should be allowed.

Claim 7, which depends on claim 6, recites transmitting the first image and the second image over a network in response to a single command from a user. Chong and Yamauchi do not disclose this feature, either. There is nothing in Chong or Yamauchi that teaches or suggests that a user gives a single command, and in response, two text-

containing images are sent over a network. Once again, the Examiner's citations to Chong nor Yamauchi are not on point. Claim 7 should be allowed.

Claim 8, which also depends on claim 6, recites displaying one of the translation of the first text and the translation of the second text in response to a command from a user. There is nothing in Chong or Yamauchi that teaches or suggests that a user gives a command, one of two translations is displayed. The Examiner's citation of Yamauchi's selective activation of "first and second output means," Yamauchi col. 4, lines 50-52, does not pertain to selection of one of two translations.

Claim 11 recites prompting a user to provide additional information. The additional information comprises at least one of an account number, a password, an identification of the first language, an identification of the second language, a dictionary and a server location. Yamauchi does not teach or suggest prompting a user for any such information.

In view of the differences identified above, Chong and Yamauchi clearly fail to anticipate the features set forth in claims 1 and 3-12. Rejection of claims 1 and 3-12 should be withdrawn.

#### **Claim Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 2 and 13-27 under 35 U.S.C. § 103(a) as being unpatentable over Chong. According to the Examiner, Chong does not explicitly teach capturing a first image containing the text in the first language, receiving instructions to edit the first image and editing the first image to generate a second image. The Examiner concluded, however, that "capturing an image using for instance a camera, and editing the image, are well known in the art. Therefore, one having ordinary skill in the art at the time the invention was made would have found it obvious to capture and edit the image because it would provide an image that the recognizer for instance a scanner is able to recognize with less degree of ambiguity and therefore would improve the translation process of the image."

In regard to claims 13-27, the Examiner stated "Claims 13-27 are the same in scope and content as claims 1-12 above and therefore are rejected under the same rationale."

Applicant respectfully traverses the rejection.

The legal standard for obviousness under 35 U.S.C. § 103(a) is well-established. The Examiner must determine whether the prior art provides a "teaching or suggestion to one of ordinary skill in the art to make the changes that would produce" the claimed invention. In re Chu, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995). A prima facie case of obviousness is established only when this burden is met, and the Examiner bears the burden of establishing a prima facie case of obviousness. In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." In re Kotzab, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

In a proper obviousness determination, the prior art must ordinarily give a reason or motivation for making the claimed invention. In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In re Lee emphasizes that evidence of motivation to combine references is not a trivial requirement, but is rather the best defense against a hindsight-based analysis. Id. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), underscores that combining prior art references without evidence of a suggestion, teaching or motivation to combine references simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, and this is the "essence of hindsight." A rigorous application of the requirement for a showing of the teaching or motivation to combine is "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis." Id.

Furthermore, In re Lee and In re Dembiczak further emphasize the importance of creation of an evidentiary record that supports a conclusion of obviousness. In re Lee, 61 USPQ2d at 1433-34; In re Dembiczak, 50 USPQ2d at 1617. The findings must be based upon evidence in the record, not upon the subjective belief of the Examiner. See In re Lee, 61 USPQ2d at 1434 (the factual inquiry into whether to combine references "must be based on objective evidence in the record"); In re Dembiczak, 50 USPQ2d at 1617 ("The range of sources available, however, does not diminish the requirement for actual evidence.").

Here, the Examiner has admitted that no motivation to combine is found in the references or any evidence of record. Instead, the Examiner asserted that the motivation

to combine was based upon general knowledge "well known in the art." This basis is legally insufficient. If there are deficiencies in the evidentiary record, the deficiencies cannot be cured by general conclusions such as "general knowledge" or "common sense." In re Lee, 61 USPQ2d at 1434; see also In re Dembiczak, 50 USPQ2d at 1617 (it was error not to make particular factual findings regarding the locus of the suggestion, teaching or motivation to combine references).

Even if the Examiner were to cite a reference disclosing image editing, such a reference would be insufficient to deny Applicant's claims. A patentable invention may arise from a combination of elements found in the prior art. It is therefore not sufficient for the Examiner merely to identify individual components of an invention in multiple references. E.g., Ruiz v. A.B. Chance Co., 57 USPQ2d 1161, 1167 (Fed. Cir. 2000). The Examiner must demonstrate that a skilled artisan, with no knowledge of Applicants' claimed invention, would have selected the components for combination in the manner claimed. In re Kotzab, 55 USPQ2d at 1316-18. It is not sufficient for the Examiner to assert that separate elements of the claimed invention exist in the prior art, or that the elements in different references could be combined, or that there is an apparent need for combination of the elements, or that elements may be substitutes for one another. Ruiz v. A.B. Chance Co., 57 USPQ2d at 1167. To establish a prima facie case of unpatentability, the Examiner must provide evidence showing a reason, suggestion or motivation to combine or to make the asserted modification.

The Examiner has not met the legal burden to show a suggestion or motivation to modify the teachings of the Chong reference. Moreover, there is nothing in Chong that supports such a motivation. The Examiner mentions editing an image captured by a camera, but Chong does not describe a camera or any interface with a camera. Nor does Chung disclose any editing capability or the desirability of same.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claim 2 under 35 U.S.C. § 103(a). Withdrawal of this rejection is requested.

As for the rejections of claims 13-27, the rejections are legally insufficient for the following reasons.

First, the basis for the rejections of claims 13-27 is unclear. The Examiner rejected claims 1 and 3-12 under 35 U.S.C. § 102(b). The Examiner rejected claim 2 under 35 U.S.C. § 103(a). The Examiner purported to reject claims 13-27 under 35 U.S.C. § 103(a), not 35 U.S.C. § 102(b). The basis for the rejection of claims 13-27 is therefore vague and confusing. Applicant does not know the statutory basis for the rejection, nor does the Applicant know what references are cited with respect to claims 13-27. The Examiner has not complied with the statutory requirement for a reasoned decision under 35 U.S.C. § 132(a) or the requirement for a reasoned decision under 37 C.F.R. § 1.104(a)(2).

Second, claims 1-12 are allowable for the reasons given above. If claims 13-27 are, as the Examiner asserted, "the same in scope and content as claims 1-12," then claims 13-27 ought to be allowed as well.

Third, claims 13-27 are not the same in scope and content as claims 1-12, and the Examiner's lumping of the claims in this fashion is clearly erroneous.

Claim 13, for example, is an independent claim reciting a method comprising receiving an image containing text in a first language over a network, translating the text to a second language, and transmitting the translation over the network. This is clearly not the same scope as independent claim 1. Claims 14 and 15, which depend upon claim 13, recite elements distinct from elements recited in claims 1-12.

Independent claim 16 is directed to a device, and claims 17-22 depend on claim 16. None of the Examiner's remarks were directed to devices in general, or to devices having the elements recited in claims 16-22. Claims 21 and 22, for example, recite a digital camera and a cellular telephone. The Examiner cited no references pertaining to these elements.

Independent claim 23 likewise is directed to a device, and claims 24-27 depend on claim 23. The Examiner made no effort to analyze the elements of the claims 23-27 or to offer a reasoned decision explaining why these claims were rejected.

For these reasons, Applicant requests withdrawal of the rejections of claims 13-27.

**New Claims:**



Applicant has added claims 28-31 to the pending application. The applied references fail to disclose or suggest the invention defined by Applicant's new claims, and provide no teaching that would have suggested the desirability of modification to arrive at the invention as claimed in claims 28-31. No new matter has been added by the new claims.

### CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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30 October 2003  
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